

## T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 27-Jun-03APPL. S.N.: 09/752,984TO: EXAMINER Tremblay, MarkART UNIT: 2827FROM: Hoppe, Sharon

PARALEGAL SPECIALIST

RETURN THIS MEMO TO: CP4-6D34SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: 16-Jun-03

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete, please initial, date and return this memo to me. THANK YOU.

- ☒ The T.D. is PROPER and has been recorded (see ¶ 14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶ 14.24):
- ☐ The TD fee of  has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶ 14.26.07).
  - ☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶ 14.26 & 14.26.01).
  - ☐ The T.D. lacks the enforceable only during common ownership clause – needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see ¶ 14.27.01).
  - ☐ The T.D. is directed to a particular claim(s), which is not acceptable since “the disclaimer must be for a terminal portion of the term of the entire patent to be granted” (MPEP 1490) (see ¶ 14.26 & 14.26.02).
  - ☐ The person who signed the T.D.:
    - ☐ is not an attorney “of record” (see ¶ 14.29 and 14.29.01).
    - ☐ has failed to state his/her capacity to sign for the business entity (see ¶ 14.28).
    - ☐ is not recognized as an officer of the assignee (see ¶ 14.29 & possible 14.29.02).
  - ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶ 14.30).
  - ☐ The T.D. is not signed (see ¶ 14.26 & 14.26.03).
  - ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶ 14.32).
  - ☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶ 14.26, 14.27.02 or 14.26.05).
  - ☐ The period disclaimed is incorrect or not specified (see ¶ 14.26, 14.27.02 or 14.26.03).
  - ☐ Other:
  - ☐ Suggestion to request refund (see ¶ 14.36). NOTE: If already authorized, credit refund to deposit account and **do not** check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials: \_\_\_\_\_ Date: \_\_\_\_\_

Log Date: \_\_\_\_\_

Special Program Database, Version 2.1

(Rev. 5/98)

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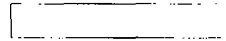
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**PATENT APPLICATION**

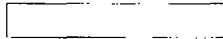


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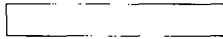
**PATENT APPLICATION**

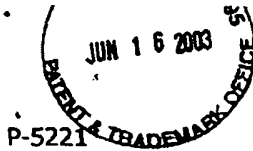


**PATENT APPLICATION**



**PATENT APPLICATION**





PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: KLAUS W. BERNDT  
Serial No.: 09/752,984 Art Unit: 2827  
Filing Date: January 2, 2001 Examiner: M. Tremblay  
For: **Apparatus for Measuring the Volume of Individual Red Blood Cells**

Commissioner for Patents  
Alexandria, Virginia 22313

**TERMINAL DISCLAIMER**

Sir:

Your Petitioner, **Becton, Dickinson and Company**, a New Jersey corporation with a place of business at 1 Becton Drive, Franklin Lakes, Bergen County, New Jersey 07417, represents that it is the assignee of the entire right, title and interest, by assignment recorded in the United States Patent and Trademark Office at reel/frame 011804/0592 of the patent application U.S. Serial No. 09/752,984, filed on January 2, 2001, for Apparatus for Measuring the Volume of Individual Red Blood Cells of Inventor Berndt.

The petitioner hereby disclaims the terminal part of any U.S. patent granted on the above-identified application of U.S. Serial No. 09/752,984 which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §154 to §156 and §173 of presently shortened by any terminal disclaimer, of U.S. Serial No. 09/753,197. The petitioner hereby agrees that any U.S. patent so granted on the above-identified application of U.S. Serial No. 09/752,984 shall be enforceable only for and during such period that the legal title to U.S. Serial No. 09/753,197 (as recorded in the United States Patent and Trademark Office at reel/frame 011710/0802 to Becton, Dickinson and Company), shall be the same as the legal title to U.S. Serial No.

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TERMINAL DISCLAIMER  
APPROVED

JUN 27 2003

TECHNOLOGY CENTER 2800  
SPECIAL PROGRAM CENTER

SHARON S. HOPPE  
PARALEGAL SPECIALIST  
TECHNOLOGY CENTER 2800

09/752,984 this agreement to run with any patent granted on the above-identified application U.S. Serial No. 09/752,984 and to be binding upon the grantee, its successors or assigns.

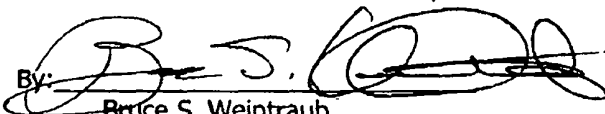
Petitioner does not disclaim any terminal part of any U.S. patent granted on the above-identified application of U.S. Serial No. 09/752,984, prior to the expiration date of the full statutory term as defined in 35 U.S.C. §154 to §156 and §173, as presently shortened by any terminal disclaimer of U.S. Serial No. 09/753,197, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321(a), has all claims canceled by a re-examination certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer filed prior to the grant of the patent, except for the separation of legal title stated above.

The undersigned has reviewed the evidentiary documents referred to in this Terminal Disclaimer and certifies that to the best of his knowledge and belief, title to U.S. Serial No. 09/752,984 and U.S. Serial No. 09/753,197 is in Becton, Dickinson and Company.

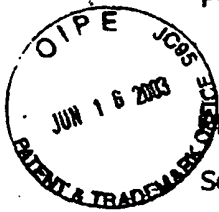
The undersigned (whose title is supplied below) is empowered to act on behalf of Becton, Dickinson and Company with respect to this document.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 6/12/03

By:   
Bruce S. Weintraub  
Attorney for Applicants  
Reg. No. 34,277

Becton, Dickinson and Company  
1 Becton Drive  
Franklin Lakes, New Jersey 07417-1880  
(201) 847-7096



P-5221

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Klaus W. Berndt  
Serial No.: 09/752,984 Art Unit: 2827  
Filing Date: January 2, 2001 Examiner: M. Tremblay  
For: **Apparatus for Measuring the Volume of Individual Red Blood Cells**

Commissioner for Patents  
Alexandria, Virginia 22313

**TERMINAL DISCLAIMER TRANSMITTAL FORM**


Sir:

Applicants herewith enclose a Terminal Disclaimer for the above-identified U.S. patent application.

The Commissioner is hereby authorized to charge \$110.00 and any additional fees which may be required, or credit any overpayment to Deposit Account No. 02-1666.

Triplicate copies of this sheet are attached.

Dated: 6/12/03

By   
Bruce S. Weintraub  
Attorney for Applicants  
Reg. No. 34,277

Becton, Dickinson and Company  
1 Becton Drive  
Franklin Lakes, NJ 07417-1880  
(201) 847-7096  
Document #66787



P-5221

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: KLAUS W. BERNDT

Serial No.: 09/752,984

Art Unit: 2827

Filing Date: January 2, 2001

Examiner: M. Tremblay

For: **Apparatus for Measuring the Volume of Individual Red Blood Cells**

Commissioner for Patents  
Alexandria, Virginia 22313

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09/752,984 this agreement to run with any patent granted on the above-identified application U.S. Serial No. 09/752,984 and to be binding upon the grantee, its successors or assigns.

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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

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By:   
Bruce S. Weintraub  
Attorney for Applicants  
Reg. No. 34,277

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1 Becton Drive  
Franklin Lakes, New Jersey 07417-1880  
(201) 847-7096

APPLICATION: 09/752,984

**Re: Terminal Disclaimer:**

RELATED APPLICATION(S) 09/753,197,

\_\_\_\_\_, \_\_\_\_\_, HAS

(HAVE) NOT ISSUED AS OF 6-27-03.